

**REMARKS**

Reconsideration and allowance of the above-referenced application are respectfully requested. Claims 3-6, 9 and 13-15 have been amended, and claims 1-15 are pending in the application.

Claims 1-6 stand rejected under 35 U.S.C. 112, second paragraph. The Examiner states that it is unclear what is meant by “a size of address field” and whether it is the “size of the address field of the tag or destination address”. The independent claims have been amended to remove the term “of the address fields”. Thus, claim 1, for example, recites “selecting by the network manager a size to be used for switching data packets...”. Page 5, lines 32 to page 6, line 33 of the specification disclose such a size (X). It is submitted that all pending claims are in full compliance with 35 U.S.C. 112, second paragraph. Therefore, the rejection should be withdrawn.

Claims 1-15 stand rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement. This rejection is respectfully traversed. The Examiner contends that the specification does not specifically state that the “header is added without altering the contents of the header”. Applicant believes the Examiner meant to state that the “switching tag is added without altering the contents of the header”, since that is what is claimed.

The Examiner is reminded that the drawings are part of the specification. Page 4, lines 10-11 of the specification state, “like elements having the same reference numeral designations represent like elements throughout...” In that regard, Fig. 3A shows a local route header 40 of a conventional packet and its content (see page 5, lines 13-23). Fig. 3B shows the switching tag 57 is added to the start 59 of the header 40 (see page 5, lines 24-31). Since the same number 40 is used in Figs. 3A and 3B, these figures define the same header and thus it is clear that no altering of the content of header 40 has occurred. Thus, Applicant submits that the specification enables one skilled in the art to make and/or use the invention and the feature that the switching tag, added to a start of the corresponding data packet without altering the content of the header, is not

new matter.

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Further, the Examiner bears the burden of explaining why any assertions of enablement in the specification are deficient: "[T]he law does not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 USC 112, first paragraph." *Staehelein v. Secher*, 24 USPQ 2d 1513, 1516 (USPTO Bd. Pat. App. Int. 1992) (*quoting In re Gay*, 135 USPQ 311, 316 (CCPA 1962) ("Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.")).

"When rejecting a claim under the enablement requirement of § 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement." *In re Wright*, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993).

Claims 3-6, 9, and 13-15 stand rejected under 35 U.S.C. 112, second paragraph as containing a trademark. The Examiner has failed to answer the material traversed. (See MPEP §707.07(f) "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.").

Furthermore, this rejection is respectfully traversed, as use of the trademark

“InfiniBand™” in the claims is not to identify “a particular material or product”, but rather to properly identify the *source* of the protocol, namely the InfiniBand® Trade Association (see, e.g., the InfiniBand® Trade Association website at “www.infinibandta.org/home” and “www.infinibandta.org/specs/”).

Section 2173.05(u) of the MPEP (Rev. 2, May 2004) explicitly states that “[t]he presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph” and cites *Ex parte Simpson* only for the instance where a trademark is used in a claim to identify or describe a particular material or product. See *Ex parte Simpson*, 218 1020, 1021-22 (Bd. Pat. App. & Inter. 1992) (claim scope uncertain as to material which forms the “Hypalon” membrane: question as to how much chlorosulphonated polythene must be present before infringement occurs). Respectfully, the statement in the rejection that the trademark is used to identify an InfiniBand™ network is inaccurate: claims 3 and 9 specify “accessing the network *according to* InfiniBand™ network protocol”. Claim 13 recites “configured for communication *according to* InfiniBand™ network protocol.”

Hence, the claims specify accessing or configuring, according to a prescribed specification identified as InfiniBand™: infringement would be determined based on whether the claimed operations operated according to the InfiniBand™ protocol that is promulgated and supported by the InfiniBand® Trade Association.

Consequently, *Ex parte Simpson* is distinguishable because the claims do not use the trademark to attempt to identify a particular material or product, but rather use the trademark to identify the protocol used in accessing the network or configuring the switch and nodes. One having ordinary skill in the art would appreciate that the InfiniBand™ network protocol that is provided under the authority of the InfiniBand® Trade Association specifies a logical sequence of events that are to occur in order to reach a certain result.

Hence, one skilled in the art would recognize that the claims should be interpreted as performing operations or functions consistent with the InfiniBand™ network protocol promulgated and supported by the InfiniBand® Trade Association.

Further, the MPEP not only permits use of trademarks having definite meanings in patent applications, but ***requires*** that the proprietary nature of the marks be respected (see, e.g., MPEP §608.01(v) at page 600-88 (Rev. 2, May 2004)).

For these and other reasons, the §112, second paragraph rejection of claims 3-6, 9 and 13 should be withdrawn.

Claim 1 stands rejected under 35 USC 102 in view of U.S. Patent No. 6,499,061 to Benayoun. This rejection is respectfully traversed.

Claim 1 as amended recites selecting by the network manager a size to be used for switching data packets traversing the network, based on a number of the detected network nodes.

There is no teaching of selecting the size based on the number of detected nodes in Benayoun. Since there is no teaching of these features in Benayoun, the Examiner states that an inherent network manager provides synchronization between network nodes 12 and 14 in Benayoun, and states that the size of the address fields in the header are inherently known in order for the address fields to be processed.

When the Examiner alleges that a certain result is inherent in the operation of a reference, it must appear that this is necessarily so without any doubt. *Ex parte Ruskin*, 95USPQ 96 (Pat. Ofc. Bd. App. 1951). See also MPEP 2112 ("The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); ... 'The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999))). Thus, the Examiner should cite a reference to support his assertion.

Furthermore, claim 1 recites, configuring by the network manager each network switch of the network to switch each of the data packets based on a corresponding switching tag, added to a start of the corresponding data packet and the switching tag having the selected size, without altering the content of the header.

The Examiner contends that in Benayoun, “each network switch (12 and 14 respectively per Fig. 1) are inherently configured to add a label or tag at the start of a data packet without altering the data packet.” This assertion, however, does not address the claim language. The claim recites that the switching tag has the selected size (as selected by the network manager). The labels 18 of Benayoun do not have a selected size as claimed. To the contrary, any routing headers added by the switch in Benayoun have a fixed size. At column 3, lines 7-17, Benayoun merely teaches that a packet has a flow-id field or other packet parameters available such as destination address, source address, port number or protocol employed.

Hence, the rejection should be withdrawn because it fails to demonstrate that the applied reference discloses each and every element of the claim. See MPEP 2131. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “Anticipation cannot be predicated on teachings in the reference which are vague or based on conjecture.” *Studiengesellschaft Kohle mbH v. Dart Industries, Inc.*, 549 F. Supp. 716, 216 USPQ 381 (D. Del. 1982), *aff’d*, 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984).

Claims 2 and 7-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benayoun in view of Fan. With regard to claim 2, this claim depends from claim 1 and is considered to be allowable for the reasons advanced above with regard to claim 1, and for the additional reason that the added subject matter thereof is not taught or suggested by the prior art of record.

With regard to independent claim 7, this rejection is respectfully traversed. It appears that this rejection should be “Fan in view of Benayoun” instead of “Benayoun in view of Fan” since the Examiner cites features of Fan, then states Fan lacks a claimed feature and then the Examiner uses Benayoun to supply the lacking feature. In any event, claim 7 recites that the switching tag has the selected size, without altering the content of the header. As noted above, the label of Benayoun does not include a selected size as claimed.

In addition, the Examiner contends it would have been obvious to add the switching tag

to the start of the corresponding data packet without altering the header as in Benayoun in place of modifying the header of Fan.

Fan teaches that "the long addresses in the packet header are *replaced* by the corresponding short addresses, and the address type (long or short) is identified in the header" (column 6, lines 49-52); hence, "the packet with the shortened header is then forwarded to the destination node within the virtual address using the short address" (col. 6, lines 55-57).

Thus, Fan requires altering the header content and modifying the header of Fan so as not to change the content, as suggested by the Examiner, would destroy the invention of Fan and would therefore be improper. See *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references). Therefore, the rejection is improper and should be withdrawn.

With regard to claim 8, this claim depends from claim 7 and is considered to be allowable for the reasons advanced above with regard to claim 7, and for the additional reason that the added subject matter thereof is not taught or suggested by the prior art of record.

Claims 3-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benayoun in view of Chui. These claims depends from claim 1 and are considered to be allowable for the reasons advanced above with regard to claim 1, and for the additional reason that the added subject matter thereof is not taught or suggested by the prior art of record.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Benayoun in view of Fan and further in view of Chui. This claim depends from claim 7 and is considered to be allowable for the reasons advanced above with regard to claim 7, and for the additional reason that the added subject matter thereof is not taught or suggested by the prior art of record.

Claims 10-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fan in view of Benayoun. This rejection is respectfully traversed.

Claim 10 recites that the switching tag has the selected size, without altering the content of the header. As noted above, the label of Benayoun does not include a selected size as claimed.

In addition, the Examiner contends it would have been obvious to add the switching tag

to the start of the corresponding data packet without altering the header as in Benayoun in place of modifying the header of Fan.

As noted above with regard to claim 7, Fan requires altering the header content and modifying the header of Fan so as not to change the content, as suggested by the Examiner, would destroy the invention of Fan and would therefore be improper. See *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references). Therefore, the rejection of claim 10 and the claims that depend there-from is improper and should be withdrawn.

Claims 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over fan in view of Benayoun in further view of Chui. These claims depend from claim 10 and are considered to be allowable for the reasons advanced above with regard to claim 10, and for the additional reason that the added subject matter thereof is not taught or suggested by the prior art of record.

In view of the above, it is believed this application is in condition for allowance, and such a Notice is respectfully solicited.

ACHARYA — Application No. 09/905,067

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-0687, under Order No. 95-512, and please credit any excess fees to such deposit account.

Respectfully submitted,

Manelli Denison & Selter, PLLC

A handwritten signature in black ink, appearing to read 'E. Stemberger', written in a cursive style.

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